

The opinion in support of the decision being entered today was ***not*** written for publication and is ***not*** binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Albino Pidutti

Appeal No. 2003-1203
Application 09/594,831

ON BRIEF

Before WARREN, MOORE and POTEATE, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellant, in the brief, and based on our review, find that we cannot sustain the rejection of appealed claims 11 through 13 and 31 under 35 U.S.C. § 102(b) as being anticipated by Koike (answer, page 3), and of appealed claims 14 through 21 under 35 U.S.C. § 103(a) as being unpatentable over Koike as applied to claims 11 through 13 and 31, further in view of Monk et al. (Monk) (answer, pages 4-5).¹

It is well settled that in making out a *prima facie* case of anticipation under § 102, each and every element of the claimed invention, arranged as required by the claims, must be found in

¹ Claims 32 through 37 are also of record, claims 33 through 37 allowed by the examiner and claim 32 objected to by the examiner as dependent on a rejected base claim (answer, pages 5-6).

a single prior art reference, either expressly or under the principles of inherency. *See generally, In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78, 7 USPQ 1315, 1317 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). Whether the teachings and inferences that one skilled in this art would have found in the disclosure of an applied reference would have placed this person in possession of the claimed invention, taking into account this person's own knowledge of the particular art, is a question of fact. *See generally, In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995), and cases cited therein (a reference anticipates the claimed invention if in fact an element that is not disclosed therein "is within the knowledge of the skilled artisan."); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968) ("[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one of ordinary skill in the art would reasonably be expected to draw therefrom.").

It is further well settled that in order to establish a *prima facie* case of obviousness under § 103(a), the examiner must show that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in this art would have led that person to the claimed invention as a whole, including each and every limitation of the claims arranged as required by the claims, without recourse to the teachings in appellant's disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Fritch*, 972 F.2d 1260, 1265-66, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988). In this respect, it is well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom, see *In re Fritch*, 972 F.2d 1260, 1264-65, 23 USPQ2d 1780, 1782-83 (Fed. Cir. 1992); *Preda, supra*,

presuming skill on the part of this person. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

The threshold issue with respect the grounds of rejection before us is whether Koike would have placed one skilled in the art and one of ordinary skill in this art in possession of a boost capacitor and “an associated MOS transistor” as required by appealed claims 11 and 12, on which all of the other appealed claims depend. The examiner points to “for example, FIG. 3 and 4” of Koike in alleging that the reference discloses MOS boost capacitor **34** associated with MOS transistor **38** as well as MOS transistor **36**, because as shown in Koike **FIG. 3**, MOS transistor **38** has a “total of three electrodes” which fits a standard dictionary definition of a “transistor”² (answer, pages 3, 7 and 8-9). Appellant submits that Koike discloses diodes **36** and **38**, each of which has two electrodes, pointing to col. 3, lines 3-21, thus falling into a standard dictionary definition of a “diode,”³ and argues that “[t]he device of Koike is more consistent with [the standard dictionary] definition of a diode than the [standard dictionary] definition [of ‘transistor’] presented by the examiner” (brief, page 8).

We find that in the passage cited by appellant, Koike discloses that “diodes **36** and **38** have the same arrangement as that of conventional ones” and describes the two “diodes” with respect to diode **36**, from which it is apparent that each of the diodes has an “anode” and a “cathode.” The relationship of the diodes and the anode and cathode regions thereof in the disclosed “self-substrate-bias circuit device shown in **FIG. 3**” as well as another embodiment shown in **FIG. 4**, is also described (e.g., col. 3, lines 22-48, and col. 4, lines 25-49). Furthermore, we find that one skilled in the art and one of ordinary skill in the art reading **FIGs. 3** and **4** even without benefit of the disclosure of Koike would have readily recognized that MOS elements **36** and **38** are wired as diodes.

² In addition to the standard dictionary cited by the examiner (answer, page 7), we find essentially the same general definition for “transistor,” which includes “contacts,” along with definitions involving different types of “transistor,” e.g., “metal oxide semiconductor field-effect transistor,” in *McGraw-Hill Dictionary of Scientific and Technical Terms* 1250, 2056 (Sybil P. Parker, ed., New York, McGraw-Hill, Inc. 1994).

³ We find that the definition for “diode” provided in the standard dictionary definition as attached to the brief, which includes “anode” and “cathode” electrodes, is essentially the same general

We are of the opinion that while it may well be that, as the examiner points out, the structure of MOS elements **36** and **38** could function as transistors, this would in fact occur only if properly wired for that purpose. Accordingly, we find as a matter of fact, Koike would have placed one skilled in the art and one of ordinary skill in this art *only* in possession of a boost capacitor associated with a diode, because there is no evidence or scientific explanation in the record establishing that the disclosure of Koike coupled with the knowledge possessed by either person would have placed that person in possession of a boost capacitor associated with an electrode.

Accordingly, because Koike, even when combined with Monk, would not have placed one of ordinary skill in this art in possession of the claimed invention encompassed by the appealed claims, we reverse both grounds of rejection.

The examiner's decision is reversed.

Reversed

CHARLES F. WARREN)	
Administrative Patent Judge)	
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JAMES T. MOORE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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LINDA R. POTEATE)	
Administrative Patent Judge)	

definition for “diode” and “semiconductor diode” in *McGraw-Hill Dictionary of Scientific and Technical Terms* 578, 1790 (*id.*).

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